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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,259	08/07/2001	Daniel Lyakovetsky	MM4459	4902

7590   04/27/2006

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EXAMINER
LY, ANH

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>12 April 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

     a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

     b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

         Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____ . A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

     (a)☒ They raise new issues that would require further consideration and/or search (see NOTE below);

     (b)☐ They raise the issue of new matter (see NOTE below);

     (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

     (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

         NOTE: *See Continuation Sheet.* (See 37 CFR 1.116 and 41.33(a)).
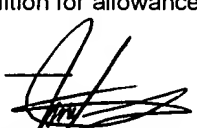
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____ .

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

     The status of the claim(s) is (or will be) as follows:

     Claim(s) allowed: _____ .

     Claim(s) objected to: _____ .

     Claim(s) rejected: *1-3,6,7 and 9-33*.

     Claim(s) withdrawn from consideration: *4,5 and 8*.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____ .

JEAN M. CORRIELUS
PRIMARY EXAMINER

Continuation of 3. NOTE:

The limitations added to independent claims such as 11, 16 and 21 requried further consideration and searches.

Continuation of 11. does NOT place the application in condition for allowance because:

Examiner maintains the rejection.

Applicants argued that, "Schumacher et al. patent does not suggest that the recorded event is intended to be automatically invoked by a computer." (Page 10, lines 21-22).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ... automatically invoked by a computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Schumacher et al. (hereinafter Schumacher) of 6,549,216 teaches a method, system and computer program product for preserving events generated from user interaction via a GUI and the methods for this process is automatically the functional testing under Java platform on the system (see figs. 8 and 11, abstract, col. 1, lines 22-67, col. 7, lines 38-65 and col. 9, lines 35-67).

Applicants argued that, "the cited combination of references does not provide a prima facie case of obviousness." (Page 11, lines 2-3).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schumacher and Guyan et al. (hereinafter Guyan) are from the same field of endeavor and both are directed to handling events generated by a user or a human operator. One having ordinary skill in the art would have found it motivated to combine the teachings of Schumacher and Guyan because that would provide Schumacher's system the enhanced capability of developing the software for handling the generation of events (see Guyan's section 0001 and 0013-0015). Moreover, the examiner kindly submits that the applicants misread the applicable references used in the last office action. However, when read and analyzed in light the specification, the invention as claimed does not support applicant's assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejections. Additionally, it is important to note that the examiner interpretation of the claims, wherein, the examiner explicitly stated passages in the cited references which were not even addressed. The aforementioned assertion wherein all the limitations are not taught or suggested by the prior of record, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. The examiner has provided in the last office action, a convincing one of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the cited references. Applicants are reminded that 37 CFR 1.111(b) states, a general allegation that the claims define a patentable invention without specifically printing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Therefore, the applicants have failed to provided prima facie evidence how the language of the claims patentably distinguished them from the cited references. Hence, the applicants' assertions are just mere allegation with no supported fact.

Applicants argued that, "the Schumacher et al. patent and the Guyan et al. publication do not includes any motive to be ...as recited in claim 11" (Page 11, the last paragraph and Page 11, the first paragraph).

Schumatcher teaches a GUI-oriented system like windows for processing an emulated sequence of events via user interaction for recoding, selecting, loading, executing and identifying an event with its responses from the stored even file (see abstract and col. 2, lines 14-62), detecting ₂the occurrence of the event such as a clicking on the

button with the mouse and response to the event. Schumatcher teaches event handling as a way of detecting and processing user input such as mouse clicks and key presses and iconifying windows (col. 1, lines 52-55). Guyan teaches identifying events that occurs in the life of a claim (sections 1304, 1641 and 1643, also see fig. 14); event handlers for the appropriate event (section 0171, 0173 and 0190); collection of event such as claims or tasks (section 0231); and making the tentative changes of the objects (sections 0242, 0322 and 1589). Also, Guyan teaches identifying events that occurs in the life of a claim (sections 1304, 1641 and 1643, also see fig. 14); event handlers for the appropriate event (abstract and sections 0016, 0171, 0173 and 0190) and collection of event such as claims or tasks (section 0231) and making the tentative changes of the objects (sections 0242, 0322 and 1589).